

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 4, 7, 8, 9 and 10 are rejected under 35 U.S.C. 103 over the U.S. patent application publication to Kim in view of the U.S. patent application publication to Lenkiewicz.

With the present Amendment applicants amended the specification to provide a reference to the priority document, to provide corresponding headings and to make some additional corrections to bring the specification in compliance with the requirements of the U.S. Patent Practice.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, the original claims have been canceled and replaced with a new set of claims including claims 13 and 18 which are independent and claims 14-17 which depend on claim 13.

It is respectfully submitted that the new features of the present invention as defined in claims 13 and 18 clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

Claims 13 and 18 define that in the dust-collection container for a hand-held power tool in accordance with the present invention a cover is provided, and a filter element is associated with the cover. Claims 14 and 18 additionally define that the cover has a plurality of air-passage openings, and the filter element is located in front of these openings so that air can pass through the filter to an outside and at the same time prevents incoming dust from coming inside the container.

Turning now to the references and in particular to the Kim and Lenkiewicz references, it is respectfully that these references disclose the dust collecting containers, in which however there is no cover with an associated filter element superimposed on the air-passage openings of the cover for allowing air to pass outside and preventing dust for coming inside the container. None of this references teach these features of the present invention as now defined in the corresponding claims.

The original claims were rejected over the above discussed references under 35 U.S.C. 103 in their combination. It is respectfully submitted that since the references do not disclose these features of the present invention and do not provide any hint or suggestion for such features, any combination of the references would lead only to such a construction, which would not include the above mentioned features as well. Thus, the present invention as defined in

the above listed claims can not be considered as obvious from the combination of the references.

In order to arrive at the present invention as defined in the above listed claims it is not just sufficient to combine the references, but the references have to be fundamentally modified by including into them the new features of the present invention which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is also respectfully submitted that the Lenkiewicz reference can not be considered as a valid reference because its U.S. filing date is October 28, 2004, while the priority of the present application is December 13, 2003 which is the earlier date.

In view of the above presented remarks and amendments, it is respectfully submitted that claims 13, 14 and 18 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 13, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

/Michael J. Striker/

Michael J. Striker
Attorney for Applicant
Reg. No. 27233